UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,125	12/11/2003	Robert Winegard	1222-3	7856

66547 7590 10/15/2007

THE FARRELL LAW FIRM, P.C.
333 EARLE OVINGTON BOULEVARD
SUITE 701
UNIONDALE, NY 11553

EXAMINER	
CURS, NATHAN M	

ART UNIT	PAPER NUMBER
2613	

MAIL DATE	DELIVERY MODE
10/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/733,125	WINEGARD, ROBERT	
	Examiner	Art Unit	
	Nathan Curs	2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 6-12* is/are rejected.

7)☒ Claim(s) *4 and 5* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 8 and depending claims 9 and 10, first recites in claim 8 the step of routing signals through an encryption device, this step being part of a method of "switching in a secure/non-secure bypass switch", and then in claim 9 recites that no power is supplied to the switch during secure mode. The specification does not support an encryption device inside a switch, not that such an encryption device is operable during a no power state of the switch.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Griffin (US Patent Application Publication No. 5666402).

Regarding claim 1, Griffin discloses a secure/non-secure bypass switch, comprising: a first port for receiving input signals (fig. 1, element LINE(1) and element 10 and col. 3, line 26 to col. 4, line 9); a first relay having an input, a first output and a second output (fig. 3C, element 84 and col. 7, lines 51-62), said input connected to said first port, and said second output connected to a second port (fig. 3C, element 84, as applicable to the base terminal, see col. 7 line 51 to col. 8 line 31 in light of col. 4 lines 16-22 and lines 36-39); a first fiber optic modem having an input and an output, said input connected to said first output of said first relay (fig. 1, element 10 and fig. 2, element 46 and col. 5, line 45 to col. 6, line 4); a second fiber optic modem having an input and an output, said input connected to said output of said first fiber optic modem (fig. 1, element 14 and col. 5, line 45 to col. 6, line 4); and a second relay having an output, a first input and a second input, said first input connected to said output of said second fiber optic modem, said second input connected to a third port, and said output connected to a fourth port (fig. 3C, element 84 and col. 7 line 51 to col. 8 line 31, as applicable to the remote terminal).

5. Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Cline (US Patent No. 4903298).

Regarding claim 11, Cline discloses a secure/non-secure bypass switch, comprising: a secure mode signal path (fig. 6, elements 221, 211, 210 and 321 and col. 7 line 29 to col. 8 line 2) and a non-secure mode signal path (fig. 6, elements 320, 210 and 321 and col. 7 line 29 to col. 8 line 2); wherein signals are routed through an encryption device connected in the secure

mode signal path when no power is supplied to the switch, and the signals are routed through the non-secure path when power is supplied to the switch (col. 13 lines 37-66).

Regarding claim 12, Claim discloses a secure/non-secure signal bypass method in a secure/non-secure bypass switch having a secure path (fig. 6, elements 221, 211, 210 and 321 and col. 7 line 29 to col. 8 line 2) and a non-secure path (fig. 6, elements 320, 210 and 321 and col. 7 line 29 to col. 8 line 2), comprising the steps of: when no power is supplied to the secure/non-secure bypass switch, routing signals through the secure path and when power is supplied to the secure/non-secure bypass switch, routing signals through the non-secure path (col. 13 lines 37-66).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2, 3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin (US Patent Application Publication No. 5666402).

Regarding claim 2, Griffin discloses the switch of claim 1, and discloses the switch operates in a non-secure mode when power is supplied to the switch (col. 3, lines 26-50). Griffin discloses that the switch needs power for the modems to operate (col. 9, line 66 to col. 9, line 30), but does not disclose details of the operation of the switch when no power is supplied to the switch. However, since the switch depends on a power supply for powered operation, it also has an inherent power-off state. It would have been obvious to one of ordinary skill in the art at the time of the invention that the power-off state of the switch would be a secure operating

state, since no data tampering or any other breach of information in the switch is possible when the switch is not powered on.

Regarding claim 3, Griffin discloses the switch of claim 2, wherein if the switch is operating in a non-secure mode, the input of the first relay is connected to the first output of the first relay, and the first input of the second relay is connected to the output of the second relay (fig. 3C, element 84 and col. 7, line 51 to col. 8, line 31).

Regarding claim 6, Griffin discloses the switch of claim 2, wherein power is supplied to the first and second fiber optic modems only during non-secure mode operation (col. 3, lines 26-50, where non-secure mode is disclosed, and col. 9, line 66 to col. 9, line 30, where power operation is disclosed).

Regarding claim 7, Griffin discloses the switch of claim 2, further comprising means for disconnecting power to the first and second fiber optic modems in the secure mode (col. 9, line 66 to col. 9, line 30, where the modems require power to operate and thus in a secure power-off state there is no power to the modems).

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin (US Patent Application Publication No. 5666402) in view of Schmid et al. ("Schmid") (US Patent Application Publication No. 2005/0025302).

Regarding claim 8, Griffin discloses a method of secure/non-secure switching in a secure/non-secure bypass switch, comprising the steps of: receiving signals to be routed (fig. 1, element LINE(1) and element 10 and col. 3, line 26 to col. 4, line 9); in a non-secure mode, configuring relays to route the signals through at least two fiber optic modems to an output port (fig. 1, elements 10 and 14 and col. 3, lines 26-50). Griffin discloses that user devices can be standard telephone handsets or secure telephones (col. 3, lines 26-50), which reads on the step

of determining if a secure or a non-secure operating mode is selected, but Griffin does not disclose any features of the secure telephones or that if a secure mode is selected, relays are configured to route the signals through an encryption device to said output port. Schmid discloses using securing telephone units, where "secure" means use of digital encryption (paragraphs 0004, 0012 and 0221-0230). It would have been obvious to one of ordinary skill in the art at the time of the invention to use digital encryption-based telephone units for the secure telephones of Griffin, to provide the advantage of communications privacy and security between the transmission devices, which is more secure than security based simply on user participation at both ends, as taught by Schmid.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 8-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/140209. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Regarding claim 8, 11/140209 claims a method of secure/non-secure switching in a secure/non-secure bypass switch, comprising the steps of: receiving signals to be routed; determining if a secure or a non-secure operating mode is selected; if a non-secure mode is selected, configuring at least one relay to route the signals through at least two fiber optic modems to an output port; and if a secure mode is selected, configuring at least one relay to route the signals through an encryption device to said output port (Claim 7). 11/140209 claims "at least one relay" instead of "relays"; however, the language "at least one" suggests the possibility of more than one. One of ordinary skill in the art at the time of the invention could have used two or more relays to route the signals, with a relay corresponding to each input/output side of the modems/encryption device and the results would have been predictable, namely, switching control of the signaling at both the input side and output side of the switching paths.

Regarding claim 9, 11/140209 claims the method of Claim 8, wherein if no power is supplied to the bypass switch the secure mode is selected (claim 8).

Regarding claim 10, 11/140209 claims the method of Claim 9, further comprising the step of disconnecting power to the fiber optic modems in the secure mode (claim 9).

Regarding claim 11, 11/140209 claims a secure/non-secure bypass switch, comprising: a secure mode signal path; and a non-secure mode signal path, wherein signals are routed through an encryption device connected in the secure mode signal path when no power is supplied to the switch, and the signals are routed through the non-secure path when power is supplied to the switch (claim 15).

Regarding claim 12, 11/140209 claims a secure/non-secure signal bypass method in a secure/non-secure bypass switch having a secure path and a non-secure path, comprising the steps of: when no power is supplied to the secure/non-secure bypass switch, routing signals

through the secure path; and when power is supplied to the secure/non-secure bypass switch, routing signals through the non-secure path (claim 15).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

11. Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments filed 25 July 2007 have been fully considered but they are not persuasive.

Regarding the rejection of claim 9 under 35 USC § 112-1st paragraph, the applicant argues that claims 8 and 9 do not recite that the encryption device is part of any switch. This is not persuasive because claim 8 claims a method of switching *in a switch*, including routing signals through an encryption device to the output port. This language puts the encryption device in the switch.

Regarding Griffin anticipating claim 1, the applicant first argues that Griffin does not teach or discloses a bypass switch. With respect to "bypass", there are no "bypass" features recited in the body of the claim, and so the term "bypass" in the preamble is essentially weightless. With respect to "switch", the Griffin system has switching (e.g. fig. 3C) and so it reads on a switch.

Next the applicant argues that LINE(1) and Base Modem 10 in Griffin fig. 1 are not connected to relay 84. This is not persuasive. There is a relay 84 in Base Modem 10

connected to LINE(1), see col. 7 line 51 to col. 8 line 31 in light of col. 4 lines 16-22 and lines 36-39 (the disclosure of the details of the ring/off-hook logic of Base Modem 10 is postponed until the discussion of Remote Modem 14 and fig. 3C). The applicant also argues that the examiner uses relay 84 to anticipate both the first and the second relay of claim 1. This is not accurate; relay 84 occurs twice in Griffin, once in modem 10 and once in modem 14.

Next, the applicant argues that the examiner does not provide any rejection of the second port, third port and fourth port from claim 1. To the contrary, the ports of the relays 84, one relay occurring in modem 10 and the other occurring in modem 14, read on these ports.

Regarding the rejection of claim 2 under 35 USC § 103, the applicant argues that the inherent power off state of Griffin is not sufficient to render unpatentable the recitation that the switch operates in a secure mode when no power is supplied to the switch, on the argued basis that the definition of "secure" used by the examiner "flies in the face of the meaning of secure/non-secure in the claims [and the specification and Schmid]". However, the definition of "secure" used by the examiner in the rejection of claim 2 corresponds to the "secure mode" limitation when it is *further limited* with the no-power limitation, not when it is claimed broadly. Also, Schmid is irrelevant to the rejection of claim 2. With respect to the rejection of claim 8, Schmid's role has to do with the encryption limitation, no the unpowered-switch limitation. Third, regardless of any kind of security features that may exist *outside* the switch, e.g. in a power consuming, active encryption device, the meaning of secure operation for the unpowered switch itself means nothing more than simply existing in an unpowered state. The applicant describes the switch as "operating in a secure when no power is supplied to the switch"; however, the switch in this "secure mode" is functionally indistinguishable from an electrically conductive wire. While in secure mode, the switch is not "operating" in any conventional sense. Any electrical

signal presented to an input port of the switch in "secure" mode will be ushered directly the corresponding output port by way of electrical conductivity.

Regarding claim 8, the applicant presents some similar arguments to those for claim 1, and so the same response above apply. The applicant also argues that the combination of Griffin and Schmid does not teach "determining if a secure or a non-secure operating mode is selected". However, the claimed "determining" only amounts to the switch simply existing in whatever mode was already selected. The claim recites "determining" if secure or non-secure mode is selected, and then configuring relays accordingly, but this does not correspond to any actual active inquiry or investigation into what mode has already been selected and then from the results of analysis/investigation setting the relays. Rather, as the switch is defined in the specification, the setting of the relays is a direct result of a push-button or toggle switch controlling whether the relays get energized or not. The only "determining", in the conventional sense, that is made before the relays are set is when an external user chooses a mode. The external user of the Griffin/Schmid system deciding to use either a secure or a standard handset reads on this kind of "determining".

Conclusion

13. Any inquiry concerning this communication from the examiner should be directed to N. Curs whose telephone number is (571) 272-3028. The examiner can normally be reached on M-F (from 9 AM to 5 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan, can be reached at (571) 272-3022. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any inquiry of

a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (800) 786-9199.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pairdirect.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JASON CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600